

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated October 7, 2008 (hereinafter Office Action) have been considered. Claims 1 and 3-40 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1, 5, 26, 28, 29, 32, and 38-39 have been amended herein. Support for the amendments can be found on at least pages 43-44 of the Detailed Description.

Claims 1, 3-25 and 32 are rejected based on 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,658,289 to Helland (hereinafter “Helland”) or alternatively in view of U.S. Patent No. 6,760,621 to Walcott et al. (hereinafter “Walcott”). Claims 26-31 and 33-40 are rejected based on 35 U.S.C. §103(a) as being unpatentable over Helland or alternatively in view of Walcott.

The Applicant notes the Examiner’s comment in the Office Action that “The examiner considers the electrode 25 and the can 40 to be subcutaneous non-intrathoracic electrodes since such a label is only a statement of intended use and the system is fully capable of being used as such” in reference to Helland. The Applicant has amended independent claims 1 and 32 to overcome the Examiner’s “intended use” concern.

The amendments also underscore aspects of the claimed subject matter clearly missing from Helland and Walcott. Helland and Walcott, for example, fail to teach or suggest a device that can operate in either of a first configuration using only subcutaneous, non-intrathoracic electrodes or a second configuration using intrathoracic electrodes. The combination of Helland and Walcott further fails to teach or suggest aspects of switching from operation in the first configuration to the second configuration in response to coupling a lead to a lead interface of the device (claim 1) or providing for parallel operation such that the second configuration acquires performance data associated with performance of a particular function by the first configuration (claim 32). This is significant because such a device is capable of providing enhanced safety for investigational use as well as upgradeability aspects associated with non-intrathoracic devices that are not contemplated by Helland or Walcott, alone or in combination.

The Applicant respectfully submits that Helland and Walcott do not teach or suggest all elements of independent claims 1 and 32, and cannot render these claims obvious under §103(a). If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, dependent claims 3-31 and 33-40 are not made obvious by Helland and Walcott.

As such, the Applicant respectfully requests withdrawal of the rejections of claims 1 and 3-40 and notification that these claims are in condition for allowance.

It is to be understood that the Applicant does not acquiesce to the Examiner's characterization of the asserted art or the Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to the Applicant's claimed subject matter. Moreover, the Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, and intended use, what something is capable of, capabilities of embodiments of the prior art, what is old and well known, and the like. The Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in the Applicant's pending claims. The Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in the future.

Authorization is given to charge Deposit Account No. 50-3581 (GUID.618PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the Examiner is invited to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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